

REMARKS

1. Applicant thanks the Office for its remarks and observations, which have greatly assisted Applicant in responding.

2. **35 U.S.C. § 102**

Claims 1-9, 11 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 6,055,513 ("Katz").

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1989)." "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimus verbis* test, i.e. identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)." MPEP § 2131.

Claim 1: The Office relies on Katz, Fig. 4, 140, Fig. 8, 280, col. 2, lines 44-47 and col. 25, lines 11-22 as teaching "receive, from a user, a product identifier"

Claim 1 describes:

"a user account database storing user account information associated with a plurality of users;

a message database storing at least one message in association with a product identifier;

a message management module operative to;

receive, from a user, a product identifier and at least one condition under which the user desires to receive information associated with the product identifier;

store the product identifier and the at least one condition in the user account database in association with the user account corresponding to the user;
receive, and store in the message database, at least one message and a product identifier associated with the message;
scan the user account database to determine whether the at least one message satisfies the conditions imposed by users;
deliver the message as to all users where the imposed conditions are satisfied. "

The Office relies on Katz, Fig. 7, 242, 260 and col. 18, lines 2-15 as teaching "receive[ing] . . . at least one condition under which the user desires to receive information associated with the product identifier." Applicant respectfully disagrees. The cited teachings describe an upsell transaction wherein Katz's system uses information about a customer to recommend one or more items after the customer makes a primary purchase. The upsell information is not associated in any way with a product identification initially received from the customer. While Katz teaches at col. 25, lines 42-43 that the customer can designate an optimum mode or manner of offer, the offer being referred to is the upsell. It has nothing to do with the original transaction and it has nothing at all to do with receiving "receiving at least one condition under which the user desires to receive information associated with the product identifier."

The Office relies on Katz, Fig. 3, 112, col. 16, lines 64-67 and col. 17, lines 1-2 as teaching "stor[ing] the product identifier and the at least one condition in the user account database in association with the user account corresponding to the user . . ." Applicant respectfully disagrees. At reference no. 112, Fig. 3 shows a local database within an upsell module of Katz's system. However, beyond mentioning the presence of the database, Katz -- in particular, the cited col. 17 teaching -- is completely silent as to the design or function of the database. The col. 16 teaching describes receiving certain inputs by the upsell system, however the cited teaching is completely silent as to which inputs are being received. Additionally, the cited teaching makes no mention at all of how or even if the inputs are stored.

The Office points to no teaching whatsoever from Katz of "receive[ing], and stor[ing] in the message database, at least one message and a product identifier associated with the message"

The Office relies on Katz, Fig. 10 as teaching "scan[nin]g the user account database to determine whether the at least one message satisfies the conditions imposed by users" Fig. 10 and the accompanying description are directed to a customer service call and a possible conclusion of an upsell transaction. They have nothing to do with determining whether a message satisfies conditions imposed by a user. Applicant notes that, at decision block 434, an assessment is made to determine if a customer is likely to be interested in an upsell offer (col. 27, lines 29-30), however Katz is completely silent as to how such assessment is made. There is no teaching or suggestion that a user account database is scanned in order to determine whether a message satisfies the conditions imposed by users. Even if it could be said that a scan took place, it would be for the purpose of qualifying the customer for the upsell, not to determine whether a message satisfies conditions imposed by the user for delivering information related to a product identifier originally supplied by a user. Only after a determination is made to extend an offer is any check of a database made – in the form of a credit check. Additionally, another database may be consulted (col. 27, lines 32-33). Katz is completely silent as to what information would be gained by a database check 438. However, the databases are consulted to provide inputs in determining which offer is to be made. They are not customer account databases and they are not checked in order to determine whether a message satisfies the conditions imposed by users (for furnishing information associated with a product identifier provided by the user). Additionally, there is no teaching in Katz that a user accounts database stores at least one product identifier received from the user or at least one condition relating to providing information associated with the product identifier.

The Office points to no teaching whatsoever from Katz of "deliver[ing] the message as to all users where the imposed conditions are satisfied."

The Office relies on Katz, Fig. 6 330, col. 9, lines 65-67 and col. 10, line 1 as teaching a user accounts database storing user account information. Applicant respectfully disagrees. The cited teachings describe a number of different databases,

but none of them teaches a user accounts database that contains user account information and that additionally stores at least one product identifier received from the user and at least one condition for receiving information associated with the product identifier.

The Office has completely failed to point out a teaching from Katz of a message database. Additionally, while the Office has pointed out subject matter from Katz that is alleged to teach the various functions of the Claimed message management module, the Office has completely failed to identify any teaching from Katz of a single module that embodies each and every one of the functions described in Claim 1.

Because Katz fails to teach each and every element of Claim 1, there is no anticipation, rendering the present rejection improper. Accordingly, Claim 1 is deemed allowable over Katz. In view of their dependence from an allowable parent Claim, Claim 1's dependent Claims are deemed allowable without any separate consideration of their merits.

Claim 7: The above remarks apply equally to Claim 7. Because Katz fails to teach each and every element of Claim 7, there is no anticipation, rendering the present rejection improper. Accordingly, Claim 7 is deemed allowable over Katz. In view of their dependence from an allowable parent Claim, Claim 7's dependent Claims are deemed allowable without any separate consideration of their merits.

In spite of the foregoing, in the interest of advancing prosecution of the Application, Applicant amends Claims 1 and 7 to describe: deliver[ing] the message as to all users where the conditions imposed by the users are satisfied. As described above, Katz is directed to a method and apparatus to a method for upselling customers after they have made an initial purchase. It has nothing to do with delivery of product information. Accordingly, there is no teaching in Katz of delivering messages (containing product information) according to conditions imposed by the user. Support for the amendments is explicit in the original Claims. The present amendments merely state more clearly what was already explicitly described in the Claims.

Therefore, even if the foregoing rejections were not meritless, they would be overcome by the present amendment.

Claim 8: The above remarks regarding Claims 1 and 7 apply equally to Claim 8. Additionally, Claim 8 is amended to describe “a message delivery module operative to, upon detection of a message code by the broadcast signal monitoring unit, retrieve a message corresponding to the message code in the message database and distribute the message to the users on the active user list according to conditions imposed by said users.” As above, there is no teaching or suggestion in Katz of delivering information to users according to conditions imposed by the users. Support for the amendment is found in the original Claims. Because Claim 8 as amended describes subject matter not taught or suggested by Katz, the present rejection is deemed improper/overcome.

In view of their dependence from an allowable parent Claim, Claim 8's dependent Claims are deemed allowable without any separate consideration of their merits.

3. 35 U.S.C. § 103

Claim 10 is rejected as being unpatentable over Katz. In view of the foregoing amendments, the present rejection is deemed overcome.

4. For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

5. No new matter is added by way of the foregoing amendments. Such are made only for expediency's sake in recognition of the Office policy of compact prosecution. They do not indicate agreement by Applicant with the Office's position. Nor do they reflect intent to sacrifice claim scope. In fact, Applicant expressly reserves the right to

pursue patent protection of a scope it reasonably believes it is entitled to one or more continuing applications.

CONCLUSION

In view of the foregoing, the Application is deemed in allowable condition. Accordingly, Applicant respectfully requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions regarding the Application, she is invited to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,



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